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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/775,746
Filing Date: February 10, 2004
Appellant(s): COX ET AL.

Brian C. Rupp
Mark Bergner
Jasmine R. Patel
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 06-25-2009 appealing from the Office action mailed 04-13-2009.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

4219596

TAKEMOTO ET AL.

08-1980

Affidavit Under 37 CFR 1.132 of Marty Jay Cox (07-08-2008)

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 3, 4, 6, 16-18, and 20-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pazar (US#2003/0167706) in view of Takemoto et al. (US#4219596).

Regarding claim 1, Pazar discloses a decorative carapace for a burial vault comprising: a carapace 2910 (Fig. 28) having a top surface; and a metal substrate (nameplate) 2310 having a decorative graphic (name and date) and being attached/adhered to the top surface via screws.

Regarding claims 1, 3, 4, and 6, Pazar fails to disclose the substrate as being a transparent substrate having a decorative graphic printed thereon wherein the substrate is attached to the carapace via a transparent adhesive. Takemoto discloses a decorative assembly comprising a transparent substrate 16 having a decorative graphic 18 printed thereon wherein the substrate is attached to a structure via a transparent adhesive (col. 3, lines 59-60) such that the graphic appears to be part of the structure as opposed to appearing "stuck on" (col. 3, lines 57-62). Therefore, as evidenced by Takemoto, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Pazar by replacing the metal substrate with a transparent substrate having a decorative graphic printed thereon wherein the substrate was attached to the carapace via a transparent adhesive. The rationale for supporting this conclusion of obviousness is the proposed combination is based upon a simple substitution of one known element for another to obtain predictable results (MPEP 2143 and *KSR International Co. v. Teleflex Inc.*). The substitution of the metal substrate with a transparent substrate having a

decorative graphic printed thereon wherein the substrate was attached to the carapace via a transparent adhesive would improve the appearance of the vault as the graphic would appear to be part of the structure.

Further regarding claim 1, Takemoto teaches the substrate can include acrylated polyester resins (col. 4, line 49).

Regarding claims 16 and 18, Pazar discloses a decorative receptacle for holding the remains of a deceased, the receptacle comprising: a container being collectively viewed as the burial vault and its carapace 2910 (Fig. 28); and a metal substrate (nameplate) 2310 having first (upper) and second (lower) sides; the substrate having a graphic image (name and date) on its first side and being attached/adhered at its second side to a first surface (upper surface of carapace) of the container via screws.

Regarding claims 16, 20, and 22, Pazar fails to disclose the substrate as being a transparent substrate having a graphic image printed thereon wherein the substrate is attached to the first surface (upper surface of the carapace) of the container via a transparent adhesive. Takemoto discloses a decorative assembly comprising a transparent substrate 16 having a graphic image 18 printed thereon wherein the substrate is attached to a structure via a transparent adhesive (col. 3, lines 59-60) such that the graphic appears to be part of the structure as opposed to appearing "stuck on" (col. 3, lines 57-62). Therefore, as evidenced by Takemoto, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Pazar by replacing the metal substrate with a transparent substrate having a decorative graphic printed thereon wherein the substrate was attached to the carapace via a transparent adhesive. The rationale for supporting this conclusion of obviousness is the proposed combination

is based upon a simple substitution of one known element for another to obtain predictable results (MPEP 2143 and *KSR International Co. v. Teleflex Inc.*). The substitution of the metal substrate with a transparent substrate having a decorative graphic printed thereon wherein the substrate was attached to the carapace via a transparent adhesive would improve the appearance of the vault as the graphic would appear to be part of the structure.

Regarding claim 17, see above analysis of claim 16. Although Pazar as modified by Takemoto fails to specifically disclose the substrate being sized to substantially cover the first surface (upper surface of the carapace) of the container, it would have been an obvious design consideration to further modify the substrate such that it was sized to substantially cover the first surface (upper surface of the carapace) of the container as a change in the size of a prior art device is a design consideration within the skill of the art. *In re Rose*, 220 F.2d 459, 105 USPQ 237 (CCPA 1955).

Regarding claim 21, the graphic image 18 taught by Takemoto is colored as it is composed of conventional inks (col. 5, lines 29-30).

Regarding claims 23 and 24, the substrate 16 taught by Takemoto is "substantially rigid" as it is a solid, cured, polymeric material (col. 4, lines 1-10), and this solid, cured, polymeric material is a continuous sheet of material without seams.

Regarding claim 25, Takemoto teaches an overcoating over the indicia (graphic image) 18 which provides a protective layer covering the graphic image.

(10) Response to Argument

The appellant presents the following argument:

A. The Commercial Success Achieved by the Invention Claimed by Independent Claims 1, 16 and 17 Demonstrates that the Claimed Invention is Not Obvious.

The appellant's showing of an increase in sales and market share despite a decreasing demand for burial vaults is insufficient to establish commercial success. The appellant has failed to establish a nexus between the claimed features of the invention and the commercial success as required per MPEP 716.03(a)-(b). Moreover, the success must be linked to the claimed invention and not to some extraneous factor (e.g. advertising; brand name recognition; market share). A mere showing of commercial success of an article which embodied the invention is not sufficient. The appellant's increase in sales may have resulted from extraneous factors such as a reduction in cost per unit, a reduction in quantity of other products offered for sale by the appellant and/or competitors, and/or advertising methods.

In response to the appellant's claim of copying by competitors, per MPEP 716.06 the showing of copying must be more than the mere fact of copying as copying may be attributable to other factors such as lack of concern for patent property.

The appellant presents the following argument:

B. A Person of Ordinary Skill in the Art Would Not Seek to Combine Pazar with Takemoto to Arrive at the Invention Claimed by Independent Claims 1, 16 and 17 of the Present Application.

The appellant specifically argues the aims of Pazar are at odds with using a decorative plastic as provided by Takemoto as plastic would not provide the durability, such as metal, required by Pazar. The examiner disagrees as the appellant has provided no evidence to support

the argument of metal being more durable than plastic for a carapace nameplate. Further, plastic would outperform metal in at least one environmental condition, namely resistance to corrosion which is a significant factor for a buried article. The appellant further argues the metal nameplate of Pazar in Fig. 23 is not "decorative". The examiner disagrees as the nameplate includes indicia and when secured to the carapace, the nameplate with indicia "decorates" the carapace to at least some degree.

In response to the appellant's argument that the appellant uses the transparent substrate for commercial desirability versus the examiner's statement that the simple substitution per *KSR* would enhance the appearance of the vault, the fact that appellant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (*Bd. Pat. App. & Inter.* 1985). Further, and as the appellant admits, the burial vault is used and thus seen at least briefly during the burial service at graveside. Thus, the transparent substrate would not only improve the appearance of the burial vault as previously discussed, but also provide commercial desirability of the burial vault when seen at the graveside. The appellant's analogy of a cinder block of an unviewable internal building wall is flawed as the burial vault is viewable at the graveside service as admitted by the appellant.

The appellant's statement that the addition of a graphic label to enhance the overall desirability of the burial vault by visual means that does not involve cross-sectional shapes, moldings, etc. had not been recognized in the industry previously is false. Pazar provides clear evidence that it was previously known to apply a graphic label (plate with indicia) to a burial

vault carapace which inherently enhances the overall desirability of the burial vault by visual means other than cross-sectional shapes, moldings, etc.

Regarding claims 1 and 16, the appellant argues the attributes of the claimed substrate are not those that one of ordinary skill in the art would turn to if the issue of durability was of primary concern and therefore one of ordinary skill in the art would not consider the teaching of Pazar in improving the desirability of a burial vault. The above argument is inaccurate as Pazar is the base reference which clearly establishes it is known to decorate a carapace via a metal nameplate (metal substrate with indicia) secured thereto. Takemoto is applied as the teaching reference to improve the Pazar carapace by replacing the metal nameplate (metal substrate with indicia) with a more visually appealing transparent, plastic, substrate with indicia as previously discussed. The plastic material would be an improvement, not reduction, in durability with respect to corrosion resistance.

Regarding claim 17, the appellant argues it makes no sense to provide a nameplate in Pazar that covers substantially the first surface of the container. The examiner disagrees as a change in size of the nameplate would be an obvious design consideration as previously discussed. The increase in size would inherently translate to the option for an increase in indicia.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/William L. Miller/

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Primary Examiner, Art Unit 3677

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